



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/575,285 | 04/11/2006 | Wolfgang E. Gallwitz | 432722003800 | 4063 |
| 25225 7590 06/24/2008 MORRISON & FOERSTER LLP 12531 HIGH BLUFF DRIVE SUITE 100 SAN DIEGO, CA 92130-2040 | | | | |
| EXAMINER WINSTON, RANDALL O | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1655 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 06/24/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/575,285

Applicant(s)

GALLWITZ ET AL.

Examiner

Randall Winston

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121 and 372:

This application contains the following inventions or groups of inventions which are not so linked as to form a single inventive concept under PCT 13.1:

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I. Claims 1-3, drawn to a first method of using: a method to stimulate the growth of hair in an area on the surface of a hair-bearing subject which method comprises administering the claimed product.

Group II. Claims 4-7, drawn to a product: a pharmaceutical or cosmetic composition comprising, as active ingredient, at least one isolated flavanoid derived from *Ginkgo biloba*.

Group III. Claims 8-9, drawn to a second method of use: a method to treat male pattern baldness which method comprises administering the claimed product.

Group IV. Claims 10-11, drawn to a third method of use: a method to encourage luxuriant growth of facial or coiffure related hair which method comprises administering the claimed product.

Group V. Claims 12-13, drawn to a fourth method of use: a method to remedy alopecia caused by radiation or chemotherapy, which method comprises administering the claimed product.

Group VI. Claim 14, drawn to a fifth method of use: a method to test the ability of a composition to stimulate the growth of hair.

Group VII. Claim 15, drawn to a sixth method of use: a method to identify or verify the ability of a composition to stimulate hair growth.

The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT 13.1, because under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of each method and/or composition is as follows:
The special technical feature of Group I is a method to stimulate the growth of hair in an area on the surface of a hair-bearing subject which method comprises administering the claimed product and The special technical feature of Group II is a pharmaceutical or cosmetic composition comprising, as active ingredient, at least one isolated flavanoid derived from *Ginkgo biloba* and The special technical feature of Group III is a method to treat male pattern baldness which method comprises administering the claimed product and The special technical feature of Group IV is a method to encourage luxuriant growth of facial or coiffure related hair which method comprises administering the claimed product and The special technical feature of Group V is a method to remedy alopecia caused by radiation or chemotherapy, which method comprises administering the

Art Unit: 1655

claimed product and The special technical feature of Group VI is a method to the test the ability of a composition to stimulate the growth of hair and The special technical feature of Group VII is a method to identify or verify the ability of a composition to stimulate hair growth.

Thus, Groups I and III-VIII are unrelated methods because each method comprise of different steps to obtain their different preamble objectives and thus do not share a special technical feature.

Furthermore, Group II is an unrelated composition to Groups I and III-VII's methods because the product as claimed can be used in a materially different process of using that product such as in Groups III or Group IV methods and thus do not share a special technical feature.

For the reasons above, the inventions of Groups I-VII do not share a special technical feature.

In addition, this application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

A. The instantly claimed one isolated flavanoid derived from *Ginkgo biloba* (e.g. as recited in claims 1 and 2)

B. The instantly claimed extract of *Ginkgo biloba* enriched in said flavanoids (e.g. as recited in claims 1 and 3)

Applicant is required, in reply to this action, to elect a single species from either Group A or Group B to which the claims shall be restricted if no generic claim is finally held to be allowable.

The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claim(s) are generic: claims 1-3

The species listed above relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The instantly claimed method of Group I are of different active method steps and/or the utilization of different compounds to obtain its preamble objective which requires a different search for the method.

Applicant is advised that the reply to this requirement to be completed must include an election of the invention to be examined even though the requirements be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Winston whose telephone number is 571-272-0972. The examiner can normally be reached on 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michele Flood/

Primary Examiner, Art Unit 1655